

Applicants: Stephan Kopytek and Virginia Cornish
Serial No.: 10/084,388
Filed: February 25, 2002
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Remarks

Claims 1-82 are pending in the subject application.

Restriction Requirement

In the May 5, 2004 Office Action, the Examiner required restriction to one of the following allegedly independent and distinct inventions characterized by the following Groups I-IV:

- I. Claims 1-31, 33-50 and 79, drawn to a method of identifying a protein or substrate from a pool of candidate proteins or substrates using an enzyme assisted chemically induced dimerization system;
- II. Claim 32, drawn to a protein cloned by the method of Group I;
- III. Claims 51-78, drawn to a transgenic cell; and
- IV. Claims 80-82, drawn to a small molecule.

On page 2 of the May 5, 2004 Office Action, the Examiner alleged that the claimed inventions are distinct each from the other. The Examiner alleged that the products of Group II and the methods of Group I are related as process of making and product made. The Examiner cited MPEP § 806.05(f) in alleging that the inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process. The Examiner alleged that in the instant case, the proteins of Group II can be made synthetically.

Additionally on page 2 of the May 5, 2004 Office Action, the Examiner alleged that the products of Group III and the methods of Group I are related as product and process of use. The Examiner cited MPEP § 806.05(h) in alleging that the inventions

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can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. The Examiner alleged that, in the instant case, the transgenic cell can be used to produce a protein such as an enzyme or receptor domain.

Further, on page 3 of the May 5, 2004 Office Action, the Examiner alleged that the products of Group IV and the methods of Group I are related as product and process of use. The Examiner alleged that, in the instant case, the small molecules of Group IV can be used to bind to cellular receptors to induce signaling pathways.

Further, on page 3 of the May 5, 2004 Office Action, the Examiner alleged that the protein of Group II, the transgenic cell of Group III and the small molecule of Group IV are distinct both physically and functionally from one another and therefore have different modes of operation, different functions and different effects. The Examiner alleged that the inventions of the different Groups are capable of supporting separate patents.

Finally, on page 4 of the May 5, 2004 Office Action, the Examiner alleged that the searches required for the different Groups are not coextensive. The Examiner alleged that these inventions are distinct for the reasons given above and have acquired a separate status in the art, Group I (435/6) versus Group II (530/350) versus Group III (514/325) versus Group IV (514/251). The Examiner alleged that restriction for examination purposes as indicated is proper.

In response, applicants hereby elect, with traverse, the invention of the claims identified as Group I, i.e., claims 1-31, 33-50, and 79, drawn to a method of identifying a protein or substrate from a pool of candidate proteins or substrates using an enzyme assisted chemically induced dimerization system.

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Applicants, however, respectfully request that the Examiner reconsider and withdraw the restriction requirement. Under 35 U.S.C. §121, restriction may be required if two or more independent and distinct inventions are claimed in one application.

In the May 5, 2004 Office Action the Examiner affirms the existing relationship of the inventions of the cited Groups I-IV. However, the inventions of cited Groups I-IV are not distinct. The protein of Group II is *identified* by the method disclosed in Group I. This protein may be made synthetically, but it is identified through the disclosed method of Group I. In addition, Groups III and IV are cells and small molecules respectively, that are *used* in the method disclosed in Group I, not a product of the process disclosed in Group I claims. These Groups are not distinct.

Furthermore, under MPEP §803, there are two criteria for a proper restriction requirement: 1) the invention must be independent or distinct (discussed above), and 2) there must be a serious burden on the Examiner if restriction is required. MPEP §803 unambiguously provides that "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent and distinct inventions." Applicants respectfully submit that there would not be a serious burden on the Examiner if restriction is not required between Groups I-IV because a search for prior art material to the patentability of the claims of any of the Groups would necessarily turn up the prior art material to the patentability of the claims of any of the remaining Groups. Since there is no burden on the Examiner to examine Groups I-IV together in the subject application, it is therefore submitted that the Examiner should examine the claims of Groups I-IV on the merits.

In view of the foregoing, applicants maintain that the May 5, 2004 restriction requirement is not proper under 35 U.S.C. §121

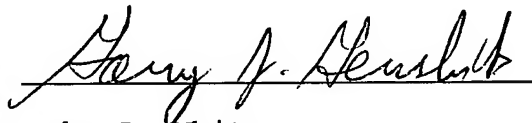
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and respectfully request that the Examiner reconsider and withdraw the requirement.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorneys invites the Examiner to telephone them at the number provided below.

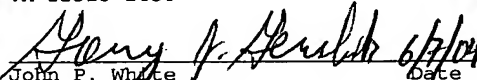
No fee is deemed necessary in connection with the filing of this Response. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

 6/7/04
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